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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/697,416 | 10/30/2003 | Paul Costain | Costain-1 | 7210 |
| 21005 | 7590 | 06/16/2006 | EXAMINER | |
| HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133 | | | ALIE, GHASSEM | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/697,416 | COSTAIN, PAUL | |
| | Examiner | Art Unit | |
| | Ghassem Alie | 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05/24/06.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) 10-19 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 16 June 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarthy (1,279,734). Regarding claims 1, McCarthy teaches a cue stick shaper for shaping and reshaping a cue tip on a cue stick used for playing pool or billiards including a base 1, 5, 6. The knife seats 5 and 6 and the cutting head 1 define a base. McCarthy also teaches an arrangement of articulates guides 17, 18 for receiving and aligning a cue stick tip Y received therebetween. McCarthy also teaches that each guide 17, 18 is independently slidable relative to the base and a scuff surface 21-23 arranged on the base in alignment with guides for shaping the plying surface of the cue tip. It should be noted that blade 21-23 are considered as a scuff surface, because blades 21-13 are capable of scratching the tip of the cue stick Y. It should also be noted that the depth of the cut on the cue stick tip by blade 21-23 is adjustable. By holding the tip of the cue stick or the playing surface of the cue stick against the scuff surface 21-23 and rotating the cue stick, an operator can sharpen the tip of the cue stick or the playing surface of the cue stick. In other words, the device in McCarthy is capable of sharpening the tip or the playing surface of the cue stick.

In addition, the tip of the cue stick is considered to be the head of the cue stick. Any part of the cue stick head is also considered to be the playing surface of the cue stick, since it can be used to hit a ball. Therefore, trimming the circumference of the tip or the head of the

cue stick is same as sharpening the playing surface of the cue stick. See Figs. 1-7 and page 1, lines 50-108 in McCarthy.

Regarding claim 2, McCarthy teaches everything noted above including that each of the guides 17, 18 has a groove thereon to define a channel receipt of only a portion of the cue stick. See Figs. 2 and 6 in McCarthy.

Regarding claim 5, McCarthy teaches everything noted above including that each of the grooves includes a V-shaped notch arrangement on a front face of each of the guides 17, 18. It should be noted the front face of the guide 17 has a V-shaped as shown in Fig. 6.

Regarding claims 6 and 7, McCarthy teaches everything noted above including that each of the guides 17, 18 is movable with respect to one another to provide an adjustable opening for the cue stick disposed therebetween. McCarthy also teaches that each of the guides 17, 18 is connected to the base 1, 5, 6. See Figs. 1, 2, and 6 in McCarthy.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Zownir et al. (4,620,370), hereinafter Zownir. Regarding claim 3, McCarthy teaches everything noted above, but McCarthy is silent about the material that forms the guides 17, 18. However, the use of plastic for forming the guide of a cue stick tip shaper is well known in the art such as taught by Zownir. Zownir teaches a cue stick tip

shaper including having guides 22, 28 made of plastic or a lubricious material. See Fig. 1 and col. 2, lines 27-40 in Zownir. It would have been obvious to a person of ordinary skill in the art to form McCarthy's guides from plastic, as taught by Zownir, in order to facilitate the manufacturing of the cue stick tip shaper and reduce the price of manufacturing the cue stick tip shaper.

Regarding claim 4, McCarthy teaches everything noted above including that the base 1, 5, 6 has an arrangement of elongated slot thereon for receipt of a shoulder screw for moving securement of the guides 17, 18 to the base. See Fig. 4 in McCarthy.

To the degree that it could be argued that the groove of each guide is not V-shaped, the rejection below is applied.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Low (790,143). Regarding claim 5, McCarthy teaches everything noted above, but McCarthy does not explicitly teach that the groove of each guide 17, 18 is has a complete V-shaped. However, the use of guides having V-shaped grooves is old and well known in the art such as taught by Low. Low teaches a cue stick tip shaper including guides 9 having V-shaped grooves. See Fig. 7 in Low. It would have been obvious to a person of ordinary skill in the art to provide McCarthy's guides with V-shaped grooves, as taught by Low, in order to enhance the grip of the cue by the guides.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Willard (4,594,782). Regarding claims 8 and 9, McCarthy teaches everything noted above including that that the scuff surface is a blade. McCarthy does not

teach that the scuff surface has a generally hemispherically shaped cutout arrangement on an upper surface of the base and the scuff surface includes a replaceable insert of grit material. However, Willard teaches a cue tip shaper including a cuff surface having a generally hemispherically shaped cutout arranged in an upper surface of a shaper base. The cutout is covered with a layer of grit material 18. It would have been obvious to one skilled in the art to replace McCarthy's blades as a scurf surface with the different type of scurf surface, as taught by Willard, in order to use shape the tip of the cue stick by an alternative way that creates a smoother finish on the tip of the cue stick.

McCarthy, as modified above, teaches everything noted above except that the layer of grit material is not form of a "replaceable insert". However, it is well known in the art to have a cue tip shaper with a shaping insert such that a new insert can be inserted when the old insert is worn down as is evident by Kratfel (See column 3, lines 16-22). In view of this fact, it would have been obvious to one skilled in the art to further modify McCarthy by making the Layer grit material "replaceable" to facilitate replacing of an old shaping insert with a new one as taught by Kratfel.

To the degree that it could be argued that the base 5, 6 in McCarthy does not have a scuff surface the rejection below is applied.

7. Claims 1, 2, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Low (790,143). Regarding claims 1, McCarthy teaches a cue stick shaper for shaping and reshaping a cue tip on a cue stick used for playing pool or billiards including a base 1, 5, 6. The knife seats 5 and 6 and the cutting head 1 define a base. McCarthy also teaches an arrangement of articulates guides 17, 18 for receiving and aligning

a cue stick tip Y received therebetween. McCarthy also teaches that each guide 17, 18 is independently slidable relative to the base. See Figs. 1-7 and page 1, lines 50-108 in McCarthy. McCarthy teaches that the base includes blades 21-23 for shaping the play surface of the cue stick tip. McCarthy does not expressly teach the base includes a scuff surface. However, the use of the scuff surface instead a blade for shaping the tip of the cue stick is well known in the art such as taught by Low. In fact, Low teaches a base which is in aligned with guides 9. Low teaches that the base alternatively includes either blades 6, 7 or scarf surface 10. See Figs. 4-8 and page 1, lines 61-42 in Low. It would have been obvious to a person of ordinary skill in the art to replace the blades in McCarthy's cut stick tip shaper with the scuff surface as taught by Low, as an alternative way for shape the tip of the cue stick.

Regarding claim 2, McCarthy teaches everything noted above including that each of the guides 17, 18 has a groove thereon to define a channel receipt of only a portion of the cue stick. See Figs. 2 and 6 in McCarthy.

Regarding claim 5, McCarthy teaches everything noted above, but McCarthy does not explicitly teach that the groove of each guide 17, 18 is has a complete V-shaped. However, the use of guides having V-shaped grooves is old and well known in the art such as taught by Low. Low teaches a cue stick tip shaper including guides 9 having V-shaped grooves. See Fig. 7 in Low. It would have been obvious to a person of ordinary skill in the art to provide McCarthy's guides with V-shaped grooves, as taught by Low, in order to enhance the grip of the cue by the guides.

Regarding claims 6 and 7, McCarthy teaches everything noted above including that each of the guides 17, 18 is movable with respect to one another to provide an adjustable

opening for the cue stick disposed therebetween. McCarthy also teaches that each of the guides 17, 18 is connected to the base 1, 5, 6. See Figs. 1, 2, and 6 in McCarthy.

8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Low, as applied to claim 1, and in further view of Zownir et al. (4,620,370), hereinafter Zownir. Regarding claim 3, McCarthy, as modified above teaches everything noted above, but McCarthy is silent about the material that forms the guides 17, 18. However, the use of plastic for forming the guide of a cue stick tip shaper is well known in the art such as taught by Zownir. Zownir teaches a cue stick tip shaper including guides 22, 28 made of plastic or a lubricious material. See Fig. 1 and col. 2, lines 27-40 in Zownir. It would have been obvious to a person of ordinary skill in the art to form the guides in McCarthy's cue stick tip shaper, as modified above, from plastic, as taught by Zownir, in order to facilitate the manufacturing of the cue stick tip shaper and reduce the price of manufacturing the cue stick tip shaper.

Regarding claim 4, McCarthy teaches everything noted above including that the base 1, 5, 6 has an arrangement of elongated slot thereon for receipt of a shoulder screw for moving securement of the guides 17, 18 to the base. See Fig. 4 in McCarthy.

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy in view of Low, as applied to claim 1, and in further view of Willard (4,594,782). Regarding claims 8 and 9, McCarthy, as modified above, teaches everything noted above except that the scuff surface has a generally hemispherically shaped cutout arrangement on an upper surface of the base and the scuff surface includes a replaceable insert of grit material. However, Willard teaches a cue tip shaper including a cuff surface having a

generally hemispherically shaped cutout arranged in an upper surface of a shaper base. The cutout is covered with a layer of grit material 18. It would have been obvious to one skilled in the art to replace the scuff surface in McCarthy's cue stick tip shaper, as modified by Low, with the different type of scurf surface, as taught by Willard, in order to make the flat scuff surface 10 into a hemispherical shape and to cover the scuff surface with a layer of grit material to facilitate shaping the cue to a proper curvature as taught by Willard.

McCarthy, as modified above, teaches everything noted above except that the layer of grit material is not form of a "replaceable insert". However, it is well known in the art to have a cue tip shaper with a shaping insert such that a new insert can be inserted when the old insert is worn down as is evident by Kratfel (See column 3, lines 16-22). In view of this fact, it would have been obvious to one skilled in the art to further modify McCarthy by making the Layer grit material "replaceable" to facilitate replacing of an old shaping insert with a new one as taught by Kratfel.

Response to Amendment

10. Applicant's argument filled on 05/24/06 have been considered but they are not persuasive. Applicant' argument that the prior art does not teach that the a scuff surface is arranged to shaping a playing surface of the cue tip is not persuasive. It should be noted that blade 21-23 are considered as a scuff surface, because blades 21-13 are capable of scratching the tip of the cue stick Y. It should also be noted that the depth of the cut on the cue stick tip by blade 21-23 is adjustable. By holding the tip of the cue stick or the playing surface of the cue stick against the scuff surface 21-23 and rotating the cue stick, an operator can sharpen

the tip of the cue stick or the playing surface of the cue stick. In other words, the device in McCarthy is capable of sharpening the tip or the playing surface of the cue stick.

In addition, the tip of the cue stick is considered to be the head of the cue stick. Any part of the cue stick head is also considered to be the playing surface of the cue stick, since it can be used to hit a ball. Therefore, trimming the circumference of the tip or the head of the cue stick is same as sharpening the playing surface of the cue stick. See Figs. 1-7 and page 1, lines 50-108 in McCarthy.

It should be noted that claims do not recite the structure of the cue stick shaper to distinguish the cue stick tip shaper of the instant invention from the prior art. For example, the exact location of the scuff surface and the exact location of the cue stick tip with respect to the scuff surface during the shaping process of the cue stick tip have not been claimed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Proper (5,228,160) and Method (2001/0029635) teach a cue stick tip shaper.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-83008300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GA/ga

June 2, 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER